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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,736	03/28/2000	Helge Bastian	C12Q1/68	5490
29425	7590	02/11/2009		
LEON R. YANKWICH 201 BROADWAY CAMBRIDGE, MA 02139			EXAMINER KETTER, JAMES S	
			ART UNIT	PAPER NUMBER
			1636	
			MAIL DATE	DELIVERY MODE
			02/11/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/536,736

Applicant(s)

BASTIAN ET AL.

Examiner

James S. Ketter

Art Unit

1636

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 56, 57, 65 and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 9-17, 22, 24-31, 33-40, 51, 53-55, 59-64, 69-74, 76-81, 83-91 and 95-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-84C)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1,3-17,22,24-31,33-40,51,53-57,59-66,69-74,76-81,83-91 and 95-100.

Claims 6-8 and 56-57 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/17/02.

The delay in the discovery and application of the reference to Ausich et al., cited and considered below, is regretted. New rejections including this reference are set forth below. Claims 95-100 were previously indicated as being drawn to allowable subject matter. However, a rejection applying the Ausich et al. reference to these claims is made below.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-5, 24, 25, 33, 34, 36, 51, 69, 72, 76-80, 90, 91 and 95-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. (of record) in view of Ausich et al. (A, newly cited).

The claimed invention was described in the Office Action of 8 August 2007. The claims are now amended to limit the pore diameter of the membrane to 1 to 50 microns.

Ogawa et al. was described previously of record. Ogawa et al. differs from the claimed invention in not teaching a membrane pore diameter of 1 to 50 microns.

Ausich et al. teaches a method of isolating a biological molecule on a filter, wherein it is suggested that the pore size be increased to avoid clogging, indicating that this was well-known in the art. Pore sizes of 8 to 400 microns is taught.

It would have been obvious to one of ordinary skill in the art to have practiced the method of Ogawa et al. as discussed previous on the record to isolate nucleic acids, using larger pores as suggested by Ausich et al., motivated by Ausich et al. to avoid clogging by so doing.

To the extent that Applicants' comments in the remarks filed 28 November 2008 might apply to the instant rejection, it is believed that the addition of the Ausich et al. reference addresses those comments.

Claims 9-14, 39, 40, 55, 59-61, 70-72, 77-78 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. in view of Mullis (both cited of record), and in further view of Ausich et al. (cited above).

The claimed invention was described in the Office Action of 8 August 2007. The claims are now amended to limit the pore diameter of the membrane to 1 to 50 microns.

Ogawa et al. and Mullis were described previously of record. Ogawa et al. and Mullis differ from the claimed invention in not teaching a membrane pore diameter of 1 to 50 microns.

Ausich et al. teaches a method of isolating a biological molecule on a filter, wherein it is suggested that the pore size be increased to avoid clogging, indicating that this was well-known in the art. Pore sizes of 8 to 400 microns is taught.

It would have been obvious to one of ordinary skill in the art to have practiced the method of Ogawa et al. using the immobilization and washing solutions of Mullis as discussed previous on the record to isolate nucleic acids, using larger pores as suggested by Ausich et al., motivated by Ausich et al. to avoid clogging by so doing.

To the extent that Applicants' comments in the remarks filed 28 November 2008 might apply to the instant rejection, it is believed that the addition of the Ausich et al. reference addresses those comments.

Claims 9-17, 22, 26-31, 35, 37-40, 53-55, 59-64, 70, 71, 73-74, 81 and 83-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. in view of Mullis, Pfister et al., Boom et al., Colpan et al. and Macfarlane et al. (all cited of record), and further in view of Ausich et al. (cited above).

The claimed invention was described in the Office Action of 8 August 2007. The claims are now amended to limit the pore diameter of the membrane to 1 to 50 microns.

Ogawa et al., Mullis, Pfister et al., Boom et al., Colpan et al. and Macfarlane et al. were described previously of record. Ogawa et al., Mullis, Pfister et al., Boom et al., Colpan et al. and

Macfarlane et al. differ from the claimed invention in not teaching a membrane pore diameter of 1 to 50 microns.

Ausich et al. teaches a method of isolating a biological molecule on a filter, wherein it is suggested that the pore size be increased to avoid clogging, indicating that this was well-known in the art. Pore sizes of 8 to 400 microns is taught.

It would have been obvious to one of ordinary skill in the art to have practiced the method of Ogawa et al. using the immobilization and washing solutions of Mullis, using the RNeasy® kit, including adding buffer RLT and ethanol according to Pfister et al., using the methods of purifying nucleic acids using various buffers as taught by Boom, using a 1-8 M chaotropic agent in combination with alcohols and phenol as taught by Colpan et al., using salts of oxalic, malonic citric or succinic acid as taught by Macfarlane et al. (for the reasons set forth in the previous rejection of record, now withdrawn in favor of the instant rejection) and using larger pores as suggested by Ausich et al., motivated by Ausich et al. to avoid clogging by so doing.

To the extent that Applicants' comments in the remarks filed 28 November 2008 might apply to the instant rejection, it is believed that the addition of the Ausich et al. reference addresses those comments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK
10 February 2009

/James S. Ketter/
Primary Examiner, Art Unit 1636